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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Marathon Oil Company
P.O. Box 4813
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EXAMINER

WONG, ALBERT KANG

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Allowability

Application No.

09/586,648

Examiner

Albert K Wong

Applicant(s)

SNIDER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 11/24/2004.
2. ☒ The allowed claim(s) is/are 83-86, 105-112 and 115-138.
3. ☒ The drawings filed on 01 June 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☒ Other Notice of Suspension.

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1. This Office action is in response to the amendment filed November 24, 2004. Claims 83-86, 105-112, and 115-138 are pending. Claims 113 and 114 have been cancelled as requested. The prior rejection of claims 83-86, 105-112, 115-119, and 136-138 under the doctrine of double patenting, with application 10/323,536, has been withdrawn in view of the Terminal Disclaimer. A prior Terminal Disclaimer was filed on September 12, 2003 to overcome conflicting claims with Patent 6,333,699.

Prior Examiner's comments

2. This application is a Continuation in Part (CIP) of application 09/286,650 (now Patent 6,333,699) which was filed on April 6, 1999. Although the specification in the instant application is different from that of the parent, the subject matter from the parent is incorporated by reference as stated on page 13. The Examiner has determined that the subject matter in claims 83-86, 105-112, 115-116, 118, 121-122, 124-128, 130, and 132-138 are fully disclosed in application 09/286,650 and are thus entitled to the April 6, 1999 priority date. Claims 117, 119-120, 123, 129, and 131 are entitled to the filing date of this application (June 1, 2000). The claims listed below recite terms that are not used explicitly within Patent 6,333,699, however, after a careful reading of the entire specification and giving reasonable inferences, the Examiner is able to find sufficient support to enable the claims for the reasons stated below.

3. Claim 110 recites the step of stopping the tool proximate to the radio id device. While such exact terms are not used in Patent 6,333,699, there is sufficient teaching to support this limitation. Col. 1, lines 37-40 teaches the need to accurately perforate a well in a zone that may be only a few feet. Col. 9, lines 3-6 and 29 teach that the reader is placed within inches and

adjacent to the id device. Both teach, indirectly, the stopping of the tool proximate to the id devices. It is not possible to achieve such a desired result without stopping the tool.

4. Claims 112, 136, and 137 recite a charge and/or the detonation of the charge in a perforation tool. While this is not explicitly stated in Patent 6,333,699, the teaching of the perforation tool is sufficient to support these limitations since the function of a perforation tool involves detonation of a charge as shown by presently cited Patent 5,680,905. In particular, see col. 6, lines 59-64.

5. Claims 116 and 130 recite that the tool is transported via "gravity." Although the term is not explicitly used in Patent 6,333,699, there is sufficient teaching to support this limitation. In particular, col. 9, lines 28-30 teach that "the line 26 is used to lower the tool 24 into the hole, and to withdraw the tool." Col. 8, lines 17-18 teach that the line "support[s] the tool." Both passages indirectly teach that gravity moves the tool.

6. Claim 122 recites a combination tool for performing multiple operations. Although the term is not explicitly used in Patent 6,333,699, there is sufficient teaching to support this limitation. Col. 14, lines 6 teaches "the tool for perforating the casing or other operations in the pipe." Col. 10, lines 54-55 teaches another pipe operation as inspection for flaws. At a minimum the tool performs the operations of perforation and determining location.

Allowable subject matter

7. Claims 83-86, 105-112, and 115-138 are allowed.

8. The following is an examiner's statement of reasons for allowance: Claims 83-86 recite a method for actuating or installing downhole equipment in a borehole by placing a downhole structure comprising a RF transmitter unit that transmits an identification code in close proximity

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to a RF receiver unit that receives the code and determining if the target depth is reached by comparing the identification code with the target code. If the id code matches the target depth, downhole equipment is actuated or installed. Such a method is not taught or suggested by the prior art of record. Claims 105-112 and 115-138 recite a method for controlling a tool by transporting a tool with a reader through a well with a plurality of radio id devices that transmits a signal that identifies the device and its depth. When the reader determines that the proper depth is reached, the tool is controlled. Such a method is not taught or suggested by the prior art of record. Claims 125-138 recites a system for performing well operations including a plurality of radio id devices at known depths in a well that transmits signal identifying the device and the depth, a reader that receives the signal from the radio id devices and controls a tool when the proper depth is reached. Such a system is not taught or suggested by the prior art of record. Beck (Patent 6,343,649) and Thomeer (Patent 6,333,700) teach methods and systems for actuation of tools based on signals from radio id devices, but their filing date do not predate the effective priority date of the claims in the instant application. Aronstam (Patent 6,443,228) teaches a system that uses radio id modules that are moved via fluid down a borehole for communication of data. Even if the subject matter was disclosed in the provisional applications filed May 28, 1999 or August 5, 1999, the priority date would not predate the effective priority date of the claims of the instant application. Sturm (Patent 5,991,602) teaches a system that uses radio devices in a well for data communication. There is no teaching or suggestion of tool actuation and there is no teaching or suggestion regarding the determination of depth.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Suspension

9. All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF 6 MONTHS from the date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert K Wong whose telephone number is 571-272-3057. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ALBERT K. WONG
PRIMARY EXAMINER

Albert K. Wong
September 27, 2005